



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/971,793	10/05/2001	Carolyn A. Brodie	YOR920010537US1	3295

7590 02/09/2009  
DAVID AKER  
23 SOUTHERN ROAD  
HARTSDALE, NY 10530

EXAMINER
----------

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
----------	--------------

3688

MAIL DATE	DELIVERY MODE
-----------	---------------

02/09/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/971,793	<b>Applicant(s)</b> BRODIE ET AL.	
	<b>Examiner</b> Donald L. Champagne	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 21 April 2008 has been entered.

### ***Drawings***

2. The drawings filed on 5 October 2001 are not of sufficient quality to permit examination. Many of the blocks and other details are too dark to be read. Accordingly, replacement drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to this Office action. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.
3. Applicant is given a TWO MONTH time period to submit new drawings in compliance with 37 CFR 1.81. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely submit replacement drawing sheets will result in ABANDONMENT of the application.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-13 and 17-19 are rejected under 35 U.S.C. 101 because the claimed invention is not directed to statutory subject matter. Based on Supreme Court precedent, to be patent eligible under 35 U.S.C. 101 a method/process claim must (1) be tied to a particular machine or apparatus or (2) transform a particular article into a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 70 (1972); *Diamond v. Diehr*, 450 U.S. 192 (1981); *Parker v. Flook*, 437 U.S. 589 n.9 (1978); and *Cochrane v. Deener*, 94 U.S. 780, 788

Art Unit: 3688

(1876)). Furthermore, the Supreme Court held that the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patentability (Benson, 409 U.S. 71-72). The involvement of the machine or transformation must not merely be insignificant extra-solution activity (Flook, 437 U.S. 590). Also see *In re Bilski*, No. 2007-1130, \_\_F.3d\_\_, 2008 WL4757.

6. The instant claims fail to meet this test. The claims fail to transform a particular article into a different state or thing. The claims are tied to a machine or apparatus, "one or more databases", but this does not qualify as a *specific* machine and does not impose a meaningful limitation. The claims are merely limited to data extraction from said databases, which is regarded as insignificant extra-solution activity.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made

8. Claims 1-13 and 17-19 are rejected under 35 U.S.C. 103(a) as unpatentable over Payne et al. (US005715314A) in view of Matyas, Jr. (US006102287A).
9. Payne et al. teaches (independent claims 1 and 19) a method for providing one or more advertising messages, which reads on alerts, over a network, the method comprising the steps of:

composing one or more alert messages/*advertisements* that are sent to alert database/*advertisement database 18* (col. 2 line 67 to col. 3 line 3 and col. 4 lines 52-54);

using the *network 10*, which reads on using network links, for gathering a plurality of reaction enabling analysis tools (said tools including the *plurality of digital advertisements*, col. 1 line 1, gathered as a result of one or more searches – *computer 20* must search *database 18* for the ad, which reads on a document with relevant data), for a user to use in a collaborative manner with other users (i.e., in conjunction or collaboration with other users

Art Unit: 3688

of the Fig. 1 sales system) to respond to the respective alert (i.e., to buy something suggested by the ad, col. 5 lines 27-28);

using data extracted from the alert database/*advertisement database 18*, to dispatch the alert messages and corresponding reaction enabling analysis tools to one or more of the clients over the network (col. 4 lines 60-63), the alert messages and corresponding reaction enabling analysis tools allowing contact with the facilities useful in responding to the alert (again, the user buying something online, col. 5 lines 27-28). For claim 19, the search and pricing/accounting tools (col. 5 lines 5-15) taught by Payne et al. read on “research and computational” tools.

10. Payne et al. does not teach determining a reaction to said alerts, comprising

users who have received the alert message and corresponding reaction enabling analysis tools cooperating with each other in conducting analysis by using the reaction enabling analysis tools to determine a reaction to said alert.

Matyas, Jr. teaches determining a reaction to said alerts, comprising the limitation given above, by providing product evaluation information (said providing being a reaction to said alert messages/*advertisements*) to potential buyers, said product evaluation information being derived from surveys of previous buyers (col. 2 line 63 to col. 3 line 2), which reads on conducting analysis by using the reaction enabling analysis tools to determine a reaction to said alert. Because Payne et al. teaches an electronic payment system (col. 3 lines 38-39) and Matyas, Jr. teaches that its invention enhances an electronic payment system (col. 3 lines 2-6), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Matyas, Jr. to those of Payne et al.

11. In addition, under *KSR v. Teleflex* (82 USPQ 2nd 1385), the combination would be obvious because prior art elements are being combined according to known methods to yield predictable results. Payne et al. teaches every feature of the claims except determining a reaction to alerts. Matyas, Jr., teaches determining a reaction to alerts and further teaches that its invention would enhance an electronic payment system, such as that taught by Payne et al.

12. Note on interpretation of claim terms - Unless a term is given a “clear definition” in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest

Art Unit: 3688

reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so “with reasonable clarity, deliberateness, and precision” (MPEP § 2111.01.III). A “clear definition” must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as “by xxx we mean”; “xxx is defined as”; or “xxx includes, ... but does not include ...”. An example does not constitute a “clear definition” beyond the scope of the example.

13. The instant application contains no such clear definition for the terms “expert” and “virtual community of interest”. Indeed, the specification does not disclose that a “subject matter expert” is functionally any different from any other user and it was noted in the last Office action (mailed on 3 July 2007, para. 10) that the users of the WWW read on a *virtual community of interest*. In the instant case, the examiner is required to give these term “expert” its broadest reasonable interpretation, which the examiner judges to be any user.
14. The following claim language, and the clause “and experts”, are non-functional descriptive material and was not given patentable weight (MPEP § 2106.01):

“and experts on the subject matter of the alert to form a virtual community of interest based on the user and what the alert is, to start a real time, collaborative session”.

This language is not functional because it does not alter how the process steps are to be performed to achieve the utility of the invention. In addition, the phrase “to start a real time, collaborative session” is not a step. Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure (MPEP § 2111.04).

15. Payne et al. also teaches at the citations given above claims 2, 3, 5, 6, 8 and 10-13.
16. Payne et al. also teaches claim 4 (col. 5 line 17, where the user request reads on a human decision); claim 7, where the *shopping cart database 21* and the *settlement database 22* (col. 5 lines 5-15) read on databases of client information, claim 9, where the contents of the *shopping cart database 21* read on a set of preferences of each user, and claim 18 (col. 6 lines 43-44).

Art Unit: 3688

17. Neither reference teaches (claim 17) providing a message if a user frequently declines to respond to ads/alerts, which reads on an infrequent customer. Because special advertising and promotions are commonly used to entice infrequent customers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the transmission of such special advertising and promotions, which reads on providing a message, to the teachings of Payne et al. and Matyas, Jr.

### ***Response to Arguments***

18. Applicant's arguments filed with an amendment on 21 April 2008 have been fully considered but they are not persuasive. None of the new material has been given patentable weight so the arguments are moot.

### ***Conclusion***

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached after Noon on Monday and Wednesday through Friday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
20. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722. The fax phone number for all *formal* fax communications is 571-273-8300.
21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
22. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their

Art Unit: 3688

registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov).

At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

3 February 2009

/Donald L. Champagne/  
Primary Examiner, Art Unit 3688